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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,578	01/08/2002	Jacques Durocher	85493-423	1432

7590 06/16/2003

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EXAMINER

KLEBE, GERALD B

ART UNIT

PAPER NUMBER

3618

DATE MAILED: 06/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
10/038,578

Applicant(s)  
Durocher

Examiner  
Gerald Klebe

Art Unit  
3618



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jan 8, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-20 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

*Gerald Klebe*  
9 June 2003

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## DETAILED ACTION

### *Restriction / Election*

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

I. Figs 1-6, drawn to an in-line skate with a boot having an outsole having a fork-like heel structure that provides a cavity between the upper and lower heel platforms of the outsole into which a deformable shaped absorption insert is sandwiched to absorb shock and vibration across the skate wheel chassis-to-boot interface, in class 280, subclass 11.225;

II. Figs 7-9, drawn to an embodiment in which the central portion of the insert is thinner than its peripheral portion, giving the insert the general shape of a horseshoe;

III. Fig 10, drawn to an embodiment in which the wheel chassis and outsole are made of a single piece of rigid plastic having the heel portion split into upper and lower platforms to forming a fork-like heel structure with cavity to receive a deformable shock and vibration absorbing insert;

IV. Fig. 11, drawn to an embodiment of an ice skate in which the blade holder extends upwardly into and outsole extending the entire length of the upper of the boot and where the blade holder is split into tow segments to form a fork-like heel structure with a cavity to receive a deformable shock and vibration absorbing insert.

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2. A telephone call was placed to the attorney of record in the case, Mr. Marc Gagnon, Reg. No. 51,273, at 9:30 AM ET on 6/09/2003, to request an oral election to the above restriction requirement. Mr. Gagnon requested that a written restriction requirement be provided. Applicant is advised that the reply to this requirement, to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

3. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there appears to be no allowable generic claim.

4. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

5. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species. MPEP  
§ 809.02(a).

*Conclusion*

7. Any inquiry concerning this communication from the examiner should be directed to  
Gerald B. Klebe, telephone 703-305-0578, facsimile 703-308-2571, between 8:00 AM and 4:30  
PM ET, Mon-Fri., or to Supervisory Patent Examiner Brian L. Johnson, Art Unit 3618,  
telephone 703-308-0885.

*gbklebe*  
gbklebe / Art Unit 3618 / 9 June 2003

*Brian L. Johnson*  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGICAL CENTER  
JUN 6 11 03